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| APPLICATION NO.                                                                                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/560,455                                                                                       | 12/14/2005  | Silvia Gluck         | 13111-00027-US      | 3072             |
| 23416 7590 03/24/2008<br>CONNOLLY BOVE LODGE & HUTZ, LLP<br>P O BOX 2207<br>WILMINGTON, DE 19899 |             |                      |                     |                  |
| EXAMINER                                                                                         |             |                      |                     |                  |
| MARX, IRENE                                                                                      |             |                      |                     |                  |
| ART UNIT                                                                                         |             | PAPER NUMBER         |                     |                  |
| 1651                                                                                             |             |                      |                     |                  |
| MAIL DATE                                                                                        |             | DELIVERY MODE        |                     |                  |
| 03/24/2008                                                                                       |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/560,455

**Applicant(s)**

GLUCK ET AL.

**Examiner**

Irene Marx

**Art Unit**

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/86)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

***Election/Restriction***

**DETAILED ACTION**

Claims 1-25 are pending and subject to restriction.

***Election/Restriction***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-7 and 18-22 drawn to a process of isomerizing alpha hydroxy carboxylic acids
- II. Claim 8-19 and 23 drawn to a process of screening microorganisms which express enzymes with alpha hydroxy carboxylic acid racemase activity.
- III. Claims 11-12 and 24-25 drawn to alpha hydroxy carboxylic acid racemase.
- IV. Claims 13 drawn to a nucleic acid,
- V. Claim 14 drawn to an expression vector
- VI Claim 15 drawn to a recombinant microorganism.
- VII. Claims 16 drawn to a method of producing a protein by culturing a recombinant microorganism.
- VIII. Claim 17 drawn to a method of isolating a protein from a microorganism.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

First, the inventions of groups I-VIII do not match a permitted category as PCT Rule 13.2 does not provide for multiple methods or products in one category. A variety of processes and compositions are claimed having distinct properties. For example, groups I, II, VII and VIII are drawn to various methods having different ingredients and endpoints, including a method of isomerizing, a method of screening, a method of producing a protein and a method of isolating a protein. In addition, groups III-VI are directed to include different compositions having distinct

chemical and physiological properties. These groups include various enzymes, various nucleic acids, various vectors and various microorganisms.

No common inventive concept is shared among groups I through VIII, since a technical relationship is lacking among the claimed inventions involving one or more special technical features because alpha hydroxy carboxylic acid racemase capable of isomerizing alpha hydroxy carboxylic acid are known in the art. See, e.g., 6,605,430, which discloses a mandelate racemase from *P. putida*. See, e.g., bridging paragraph between col. 48 and col. 49 et seq.

The requirement of unity of invention is not fulfilled because there is no technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Therefore, a technical relationship is lacking among the claimed inventions involving one or more special technical features.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/  
Primary Examiner, Art Unit 1651